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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/601,059 | 06/20/2003 | Shu-Ping Yang | 1443.064US1 | 5526 |
| 21186 | 7590 | 03/24/2006 | EXAMINER | |
| SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402 | | | AUDET, MAURY A | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1654 | | |

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/601,059 | YANG ET AL. | |
| | Examiner Maury Audet | Art Unit 1654 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 24-30 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) 18-23 and 31-33 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 June 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>See cont.</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claims 1-33 are pending, following restriction and subsequent election of the invention.

Election/Restrictions

Applicant's election with traverse of Group II, claims 18-33, in the reply filed on 01/26/2006, is acknowledged. The traversal is on the ground(s) that it would not be unduly burdensome to search the compositions of Group I with the present methods of Group II. Applicant's argument has been considered but is not persuasive. As to the search of any of both the composition and method comprising distinct peptides within any of formulae I-IV, lacking a substantial, core peptide structure therebetween to allow for a coextensive search, the Examiner asserts, as defined in the restriction, that a search thereto would be unduly burdensome.

However, the Examiner was willing to search peptides consisting of SEQ ID NOS: 12 and 13, along with the elected compound of invention of SEQ ID NO: 1 for use in the elected invention of Group II, methods of using the same for decreasing growth of chondrosarcoma.

The Examiner was open to rejoining Group I, as to compositions consisting of SEQ ID NOS: 11-13; however, the elected SEQ ID NO: 1 and rejoined SEQ ID NOS: 12-13, have already been allowed in compositions/products, in a previous application Examined by this Examiner: US 10/153,185, now US 6906036.

Thus the traversal as to rejoinder of SEQ ID NOS: 12-13 and rejoinder of Group I with the elected invention of Group II, consisting of SEQ ID NOS: 11-13, is deemed moot in view of the above.

Claims 1-17, and 24-30 are withdrawn as being directed to non-elected subject matter.

Claims 18-23 and 31-33, drawn to a method for decreasing growth of chondrosarcoma comprising a peptide selected from the group consisting of SEQ ID NOS: 11-13, are herein examined on the merits.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 18-23 and 31-33 are objected to because of the following informalities: the claims are drawn to non-elected subject matter, namely method for decreasing growth of chondrosarcoma comprising any peptide of formula's I-IV, beyond the elected method for decreasing growth of chondrosarcoma comprising a peptide selected from the group consisting of SEQ ID NOS: 11-13.

Appropriate correction is required.

Allowable Subject Matter

Claims 18-23 and 31-33, as drawn to a method for decreasing growth of chondrosarcoma comprising a peptide selected from the group consisting of SEQ ID NOS: 11-13, is not reasonably taught or suggested by the prior art of record. Although the prior art teaches peptides comprising the peptides of SEQ ID NOS: 11-13 for various uses, the prior art of record does not teach or suggest these peptides consisting of SEQ ID NOS: 11-13, nor for their enabled use of decreasing growth of chondrosarcoma. Were applicant to amend the claims to be directed in scope to the elected invention, a method for decreasing growth of chondrosarcoma comprising a

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peptide selected from the group consisting of SEQ ID NOS: 11-13, the claims would likely receive favorable consideration.

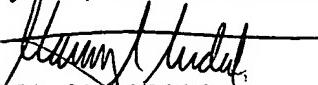
Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MA, 03/16/2006

Maury Audet
PATENT EXAMINER
ART UNIT 1654

IDS's: 11/03, 06/05, 09/05, 11/05, 03/06